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REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, both the undersigned and John Pokotylo would like to thank Examiner Sanders and Supervisory Patent Examiner Vo for courtesies extended during the telephone interview on November 4, 2009 (referred to as "the telephone interview"). The telephone interview is summarized here.

Telephone Interview Summary

This statement summarizes the issues discussed during the November 4, 2009 telephone interview. Further, this Telephone Interview Summary is presented in the format suggested in M.P.E.P. § 713.04 by the Patent Office.

**Date of Interview:** November 4, 2009

**Type of Interview:** Telephonic Conference

**Name of Participant(s):**

- Examiners: Tim Vo (SPE)  
Aaron J. Sanders
- For Applicants: John C. Pokotylo  
Len Linardakis

**A. Exhibit(s)/Demonstration(s):**

- None

**B. Claims discussed:**

- 1, 5, 7, 9-16 and 42

**C. Reference(s) Discussed:**

- U.S. Patent Publication No. 2004/0054589 ("the Nicholas publication")
- U.S. Patent No. 6,804,659 ("the Graham patent")
- U.S. Patent Publication No. 2004/0044571 ("the Bronnimann publication")

**D. Proposed Amendments Discussed:**

- Examiner Sanders suggested amending independent claim 1 to further clarify what is meant by "not available for analysis" to preclude his interpretation that the document is not available at all.

**E. Principal Arguments:**

- With respect to the 35 U.S.C. § 112, first paragraph rejection, the applicants' representatives explained that dependent claims 5, 7 and 9-16 are

supported by the specification and merely explicitly recite additional iterations in which different conditional branches of the same method are processed, as supported, for example, by Figure 4 and paragraphs [0040]-[0054] of the specification. This was done instead of using conditional language.

- With respect to the 35 U.S.C. § 103 rejections, the applicants' representatives described embodiments consistent with the invention of claims 1, 5 and 42, their understanding of the teachings of the Nicholas publication, the Graham patent and the Bronnimann publication, and the differences between the claimed invention and the teachings of the cited references.

- The applicants' representatives noted that in both the Nicholas publication and the Graham patent the document is always available for analysis.

- The applicants' representatives noted that the Bronnimann publication does not teach determining whether net revenue for the ad system for serving the ad will not be positive.

***F. Other Pertinent Matters:***

- None.

***G. General Results/Outcome:***

- With respect to the 35 U.S.C. § 112, first paragraph rejection, Examiner Sanders stated that he understood that recited elements were additional iterations and not new steps being added. Examiner Sanders noted that the explanation provided should be sufficient but that he would need to look at it further once he received our arguments.

- With respect to the 35 U.S.C. § 103 rejection of claim 1, Examiner Sanders noted that the lack of demographic information (i.e., "not available for analysis") in the Nicholas publication may read on the claims as recited. Examiner Sanders suggested amending independent claim 1 to further clarify what is meant by "not available for analysis" to preclude his interpretation that in some instances it is possible that the document is not available at all.

**Rejections under 35 U.S.C. § 112**

Claims 5, 7 and 9-16 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, claim 5 has been amended and does not include the subject matter the Examiner contends was not described in the specification.

Next, in rejecting claims 7 and 9-16, the Examiner states:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the specification does not mention "second" or "third" ad requests, "second" or "third" targets, "second" or "third" resources, or "second" entity.

(Paper No. 20090824, pages 2 and 3) The applicants respectfully disagree.

During the telephone interview, the applicants' representatives explained that the recited "second" or "third" ad requests, "second" or "third" targets, "second" or "third" resources, or "second" entity are inherently supported by the specification. Specifically, claims 7 and 9-16 merely recite **additional iterations in which different conditional branches of the same method as processed, as supported, for example, by Figure 4 and paragraphs [0040]-[0054] of the specification.** It was explained that this was done instead of using conditional language. The applicants' representatives noted that one skilled in the art would understand that an automated method is intended to be run multiple times and handle multiple possible conditions. During the telephone interview Examiner Sanders stated that he understood that recited elements were additional iterations and not new steps being added and that this explanation should be sufficient.

Thus, in view of the foregoing, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Claims 9 and 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. Specifically, the Examiner states that the term "sufficiently" is indefinite. (See Paper No. 20090824, page 3.) Since claims 9 and 10 have been amended to remove the term "sufficiently", the applicants

respectfully request that the Examiner reconsider and withdraw this ground of rejection.

**Rejections under 35 U.S.C. § 103**

Claims 1-3, 5, 9-11, 17, 18, 20-25, 27-31, 36, 37 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0054589 ("the Nicholas publication") in view of U.S. Patent No. 6,804,659 ("the Graham patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claims 1 and 36, as amended, are not rendered obvious by the Nicholas publication and Graham patent since the cited references neither teach, nor make obvious, ***determining, with a first entity and responsive to an ad request, that the content included in a target document cannot be analyzed by the first entity to determine if an ad relevant to the content of the target document is available for rendering.***

In rejecting previously presented claim 1, the Examiner states:

Nicholas teaches "determining, by the computer system of the first entity and responsive to the first ad request, [demographic information of the user] to determine if an ad relevant to the content of the first target document is available for rendering," see Fig. 25 and par. 103, "A determination of demographic information related to user is then made during a stage S418 of the flowchart 410. . . Based on the

demographic determination, ad selection node 140 checks for an ad based on the demographic information during a stage S420 of the flowchart 410."

(Paper No. 20090824, page 4) The Examiner concedes that:

Nicholas does not teach "determining... that the first target document is not available for analysis by the first entity."

(Paper No. 20090824, page 4) To overcome this admitted deficiency, the Examiner cites the Graham patent and states:

Graham teaches that "the contents of the document is again analyzed using the same technique as in step 402, to determine relevance between the document and concepts which represent advertiser definitions," see col. 8, 11. 61-64 and Fig. 4A, step 406. It would have been obvious to one of ordinary skill in the database art at the time of the invention to first check the availability of the target document before analyzing it **because some connections can be temporary, see Nicholas par. 43**. Further, it would have been obvious to one of ordinary skill in the database art at the time of the invention to combine the teachings of the cited references because Graham's teachings would have allowed Nicholas' method to provide targeted ads based on document content, see Graham col. 1, 11. 51-65. [Emphasis added]

(Paper No. 20090824, pages 4 and 5) The applicants respectfully disagree.

In the Nicholas publication, "[a] determination of demographic information related to [a] user is ... made." Based on the demographic determination, "ad selection node 140 checks for an ad based on the demographic information." If an "appropriate targeted ad" (based on the demographic determination) does not exist in the Nicholas publication, "ad selection node 140 may forward the request for an ad to a default service from content provider node 130." (Paragraph [0103] of the Nicholas publication) Thus, as can be appreciated from the foregoing, only when an "appropriate targeted ad" (based on the demographic determination) does not exist in the Nicholas publication does the system forward the ad request. ***The Nicholas publication does not consider or describe a situation where the target document cannot be analyzed,*** nor does it need to since the ads are based on demographic information of the user and are not described as being relevant to the content of the target document. Similarly, the ***Graham patent also does not consider or describe a situation where the target document cannot be analyzed.*** The Examiner contends that determining the availability of the target document for analysis is inherently done and cites paragraph [0043] of the Nicholas publication as teaching that "connections can be temporary".

During the telephone interview, the applicants' representatives noted that [0043] of the Nicholas publication does not teach that a target document may not be available, but rather merely describes certain telecommunications systems as permanent connections

(e.g., wire or fiber optic cables) and others as temporary or shared connections made through telephone or wireless communications.

Although Examiner Sanders agreed that [0043] may not be applicable, he noted that the lack of demographic information in the Nicholas publication may be characterized as "not available for analysis" and may read on the claims as recited. Examiner Sanders suggested amending independent claim 1 to further clarify what is meant by "not available for analysis" to preclude his interpretation that the document is not available at all.

Although the applicants do not agree that the Examiner's interpretation reads on the claims, and did not find anything in the Nicholas publication which described the situation presented by the Examiner, claims 1 and 36 have been amended to recite that the target document is accessible by the first entity and includes content, and that the content included in the first target document cannot be analyzed.

Thus, since the Nicholas publication and the Graham patent neither teach, nor make obvious, determining that the content included in an accessible target document cannot be analyzed by the first entity to determine if an ad relevant to the content of the target document is available for rendering, claims 1 and 36, as amended, are not rendered obvious by the cited references. Since claims 2, 3, 5, 9-11, 17, 18, 20-25, 27-31 and 39, as amended, directly or indirectly depend from claim 1, and since claim 37 depends from claim 36, these claims are similarly not rendered obvious by the cited references.

Furthermore, dependent claim 11 has been amended to recite the actions to be taken responsive to the determination that a threshold number of ads **having untapped budgets** are not available to render in association with the second target document. This amendment is supported by paragraphs [0045] and [0049] of the present application. The Nicholas publication and the Graham patent neither teach, nor make obvious, the recited features of dependent claim 11, as amended. Thus, dependent claim 11 is not rendered obvious by the cited references for at least this additional reason.

Claims 7, 8 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nicholas publication, in view of the Graham patent, and in view of U.S. Patent Application Publication No. 2003/0131095 ("the Kumhyr publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, dependent claims 7 and 8 indirectly depend from claim 1. The purported teachings of the Kumhyr publication would not compensate for the deficiencies of the Nicholas publication and the Graham patent with respect to claim 1, discussed above, regardless of the scope of purported teachings of the Kumhyr publication, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 7 and 8 are not rendered obvious by the cited references for at least this reason.

Further, independent claim 41 has been amended to recite indicating the availability of at least a portion of the resource of the target document to the publisher

associated with the target document **based on the determination that a threshold number of ads having untapped budgets are not available to render in association with the target document**, wherein the act of determining that a threshold number of ads having untapped budgets are not available to render in association with the target document includes determining that the number of ads for which advertisers are willing to pay the ad serving system does not exceed a defined threshold. This amendment is supported by paragraphs [0045] and [0049] of the present application. The Nicholas publication, the Graham patent, and the Kumhyr publication neither teach, nor make obvious, the recited features of claim 41, as amended. Thus, in view of the foregoing amendment, claim 41 is not rendered obvious by the cited references.

Claims 12-16 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nicholas publication, in view of the Graham patent, and in view of U.S. Patent Application Publication No 2004/0044571 ("the Bronnimann publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, dependent claims 12-16 indirectly depend from claim 1. The purported teachings of the Bronnimann publication would not compensate for the deficiencies of the Nicholas publication and the Graham patent with respect to claim 1, discussed above, regardless of the scope of purported teachings of the Bronnimann publication, and regardless of the absence or presence of an obvious reason to combine these references.

Consequently, claims 12-16 are not rendered obvious by the cited references for at least this reason.

Furthermore, claims 12 and 42 are not rendered obvious by the cited references since the cited references do not teach, or make obvious, indicating the availability of at least a portion of the resource of the target document to the publisher associated with the target document **based on the determination that what net revenue for the content ad system for serving the ad will not be positive.** In rejecting claim 42, the Examiner concedes:

Nicholas does not teach "determining, by the content ad serving system and responsive to the ad request associated with the target document, that net revenue for the content ad system for serving the ad will not be positive."

(Paper No. 20090824, page 34) To overcome this admitted deficiency, the Examiner cites the Bronnimann publication and states:

Bronnimann teaches that "if five listings are to be output for a keyword to a search engine system, then the system analyzes the optimized revenue efficiency for five advertisements in that grouping," see par. 7. It would have been obvious to one of ordinary skill in the database art at the time of the invention to determine which advertisements would generate negative revenue because web server owners prefer to maximize revenue, see Bronnimann par. 5. Further, it would have been obvious to one of ordinary skill in the database art at the time of the invention to combine the

teachings of the cited references because Bronnimann's teachings would have allowed Nicholas' method to optimize advertisement revenue, see Bronnimann par. 5. [Emphasis added.]

(Paper No. 20090824, page 34) The applicants respectfully disagree.

The Bronnimann publication "determines the most efficient grouping of advertisements for a limited-space output, comparing groupings of advertisements to other groups to determine the greater revenue to the distribution system." (Abstract of the Bronnimann publication) Specifically, the portion of the the Bronnimann publication cited by the Examiner provides:

[0007] According to yet another embodiment, the system analyzes ranked listings in a grouping, such as a grouping based on the targeted output format. For example, if five listings are to be output for a keyword to a search engine system, then the system analyzes **the optimized revenue efficiency** for five advertisements in that grouping. Or, in a content portal page, **if there are five slots for advertisements in that portal page, then the system analyzes various groupings of advertisements to fill those five slots to determine which groupings in those five slots generates the most revenue per impression.** This enhanced embodiment recognizes that diversity, for example, within a limited number of slots may realize the most revenue per impression for some advertising venues. [Emphasis added.]

(Paragraph [0007] of the Bronnimann publication)

As can be appreciated from the foregoing, in the Bronnimann publication "the system analyzes ***the optimized revenue efficiency*** for five advertisements in that grouping. [Emphasis added.]" (Paragraph [0007] of the Bronnimann publication) However, this does not teach determining that ***net revenue for the content ad system for serving the ad will not be positive***. The Bronnimann publication merely "determine[s] which groupings [of advertisements] in those five slots generates the most revenue per impression." (Paragraph [0007] of the Bronnimann publication)

Furthermore, as highlighted above, "***if there are five slots for advertisements in that portal page, then the system analyzes various groupings of advertisements to fill those five slots to determine which groupings in those five slots generates the most revenue per impression*** [Emphasis added]." (Paragraph [0007] of the Bronnimann publication) Nowhere does the Bronnimann publication, or the Nicholas publication, describe a situation where less slots are filled because the ad system determines that net revenue for serving an ad will not be positive.

Thus, independent claim 42, is not rendered obvious by the cited references for at least this additional reason. Dependent claim 12, as amended, and claims 13-16 (which directly or indirectly depend from claim 12) are similarly not rendered obvious by the cited references.

### **Conclusion**

In view of the foregoing amendments and remarks, the applicant respectfully submits that the pending claims

are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments (or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicant's right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.


Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met.

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Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

November 24, 2009

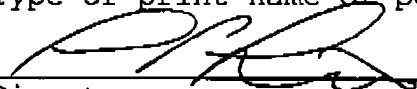
  
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